

Notice of Allowability

Application No.

10/713,651

Examiner

J. Derek Rutten

Applicant(s)

SHAPIRO, MICHAEL W.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 3/15/07.
2. ☒ The allowed claim(s) is/are 1, 7-15, 17-22, 24-32, and 34-36 (renumbered 1-28).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

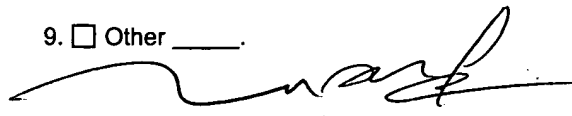
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit
of Biological Material

5. ☐ Notice of Informal Patent Application
6. ☒ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____


TUAN DAM
SUPERVISORY PATENT EXAMINER

DETAILED ACTION

1. This action is in response to Applicant's submission filed 3/15/07, responding to the 1/12/07 Office action which detailed the rejection of claims 1-41. Claims 1, 10-15, 17-22, 24-32, 34-36 have been amended, and claims 2-6, 16, 23, 33, and 37-41 have been canceled. Claims 1, 7-15, 17-22, 24-32, and 34-36 remain pending in the application and have been fully considered by the examiner.

Response to Arguments/Amendments

2. Applicant's amendments to the specification and to claim 10 have overcome the prior specification and claim objections, which are therefore withdrawn.

3. Applicant's amendment to claim 1 has overcome the rejection of claims 1, 7-9, and 19 under 35 U.S.C. § 101. These rejections are withdrawn. Further, the rejection of claims 2 and 6 are withdrawn in view of the cancellation of those claims.

4. Applicant's amendment of claims 22, 24-32, 34 and 35 are not sufficient to overcome the prior rejections under 35 U.S.C. § 101. On page 16 filed 3/27/07, Applicant essentially argues that the inclusion of a "tracing framework" and other elements that could be considered as functional descriptive matter and is therefore statutory. However, the mere presence of functional descriptive matter is not enough to provide a statutory basis for the claims since both types of "descriptive material" (i.e. functional and non-functional) are nonstatutory when claimed as descriptive material per se, *33 F.3d at 1360*, *31 USPQ2d at 1759*. The "tracing framework" of claims 22, 24-32, 34 and 35 appears to be directed to functional descriptive material per se, and is considered non-statutory. In contrast, when functional descriptive material is recorded on

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some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. For the above reasons, Applicant's arguments are not persuasive. However, an examiner's amendment to claim 22 appears below which overcomes the rejections under 35 U.S.C. § 101.

5. Applicant's amendments have overcome the previous rejections under 35 U.S.C. § 112, 2nd paragraph. Likewise, these rejections are withdrawn.

6. Applicant's arguments, see pages 19-20, filed 3/27/07, with respect to the rejection of claims 1-6, 8-11, 13-14, 19, 22-23, 25-28, 30-31, and 36-41 under 35 U.S.C. § 103 have been fully considered and are persuasive. Further arguments regarding claims 7, 12, 15-18, 20, 21, 24, 29, and 32-35 are based upon previously presented arguments and are likewise persuasive. Claims 2-6, 16, 23, 33, and 37-41 have been canceled. Therefore, the rejections of claims 1-41 have been withdrawn.

EXAMINER'S AMENDMENT

7. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Robert P. Lord, Reg. No. 46,479 on 4/10/2007. The amendment was authorized in order to obviate issues regarding 35 U.S.C. § 101.

The application has been amended as follows:

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--Begin Examiner's Amendment--

In the Claims:

Please amend claim 22 as follows:

In Claim 22, line 1, after "framework", please insert --, stored on a computer readable memory,--.

--End Examiner's Amendment--

Allowable Subject Matter

8. The following is an examiner's statement of reasons for allowance:

As indicated by the Applicant (see top of page 20 filed 3/15/07), the cited prior art taken alone or in combination fail to teach, in combination with the other claimed limitations, validation of instructions and performing a safety check for evaluation of the safety of a tracing program including: "completing virtual machine emulation of a safe instruction in the plurality of instructions..., after aborting virtual machine emulation of the unsafe instruction," as required by the amended claims. These limitations are present in each of independent claims 1, 22, and 36. The distinctions provided by the independent claims apply equally to all dependent claims. Thus all pending claims 1, 7-15, 17-22, 24-32, and 34-36 are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Derek Rutten whose telephone number is (571)272-3703. The examiner can normally be reached on M-F 7:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on (571)272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jdr



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